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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/726,618

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EXAMINER

RAJ, RAJIV J

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/726,618	Applicant(s) BONISSONE ET AL.	
	Examiner RAJIV J. RAJ	Art Unit 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on 22 June 2009.
2. Claim 17 has been amended.
3. Claims 1-18 have been examined in this application.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1, 3-5, 7-9, 11-13 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lerner et al. (US 20020087364 A1) (hereinafter Lerner) in view of Ghouri (US 2004/0049506 A1) (hereinafter Ghouri).

As per claim 1, Lerner teaches a method for using medication and medical condition information in automated insurance underwriting, the method comprising the steps of:

- *identifying medical condition information provided by the applicant*; (see at least Lerner [0022] “the server system prompts the user for responses to policy specific questions (e.g., age, sex, state of residence, medical and family history (e.g., history of cancer, heart disease, etc.), current medical condition and lifestyle”)
- *making at least one insurance underwriting decision based on the consistency between the medication information and the medical condition information*; (see at least Lerner [0024] “A total risk factor or eligibility score is calculated by adding the individual assessment values assigned to the potential customer at step 162 after review of the medical and application information. This total score represents a comprehensive quantified assessment of the potential customer insurability, and is used to make decisions on whether or not to underwrite a life insurance policy”)

Lerner does not disclose the following limitations, however Ghouri, as shown does:

- *identifying medication information provided by an applicant*; (see at least Ghouri [0019] Fig:1,2 & related text)
- *assessing a consistency between the medication information and the medical condition information, the assessing consistency between the medication*

information and the medical condition information performed by the processor;

(see at least Ghouri [0019] Fig:1,2 & related text)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the features of Ghouri into Lerner. One of ordinary skill in the art would have added these features into Lerner with the motivation to provide a more efficient and accurate approach to assessing the consistency between medication information and the medical conditions in order to yield more informed and beneficial medical decisions. (see at least Ghouri [0008]-[0013])

As per claim 3, Lerner teaches the steps of:

- *querying a medical knowledge database, the database comprises information associated with a plurality of medications, a plurality of medical conditions, and treatment associations between the plurality of medications and the plurality of medical conditions. (see at least Lerner [0017] “accessing the server via the network and one or more information systems or databases . . . The information typically includes HMO claims records, medical laboratory test reports and/or computerized results from previous hospital or doctor office examinations. The nature of the particular records stored and accessed may vary widely, depending upon the nature of the insurance or policy desired.”)*

As per claim 4, Lerner teaches:

- *assigning the applicant to a risk category based on the consistency between the medication information and the medical condition information. (see at least Lerner Fig. 2 Items:56,72 and related text)*

As per claim 5, Lerner teaches the steps of:

- *code adapted to identify medication information provided by an applicant; code adapted to identify medical condition information provided by the applicant; (see at least Lerner [0022])*
- *code adapted to assess a consistency between the medication information and the medical condition information; (see at least Lerner [0023])*
- *code adapted to make at least one insurance underwriting decision based on the consistency between the medication information and the medical condition information. (see at least Lerner [0024])*

As per claim 7, Lerner teaches the steps of:

- *code adapted to query a medical knowledge database, the database comprises information associated with a plurality of medications, a plurality of medical conditions, and treatment associations between the plurality of medications and the plurality of medical conditions. (see at least Lerner [0017])*

As per claim 8, Lerner teaches:

- *code adopted to assign the applicant to a risk category based on the consistency between the medication information and the medical condition information. (see at least Lerner Fig. 2 Items:56,72 and related text)*

As per claim 9, Lerner teaches the system comprising:

- *a first identification module identifying medication information provided by an applicant; a second identification module identifying medical condition information provided by the applicant; (see at least Lerner [0022])*
- *a assessment module assessing a consistency between the medication information and the medical condition information; (see at least Lerner [0023])*
- *an insurance module for making at least one insurance underwriting decision based on the consistency between the medication information and the medical condition information. (see at least Lerner [0024])*

As per claim 11, Lerner teaches the steps of:

- *a query module for querying a medical knowledge database, the database comprises information associated with a plurality of medications, a plurality of medical conditions, and treatment associations between the plurality of medications and the plurality of medical conditions. (see at least Lerner [0017])*

As per claim 12, Lerner teaches:

- *an assignment module for assigning the applicant to a risk category based on the consistency between the medication information and the medical condition information. (see at least Lerner Fig. 2 Items:56,72 and related text)*

As per claim 13, Lerner teaches the system comprising:

- *means for identifying medication information provided by an applicant; means for identifying medical condition information provided by the applicant; (see at least Lerner [0022])*

- *means for assessing a consistency between the medication information and the medical condition information;* (see at least Lerner [0023])
- *means for making at least one insurance underwriting decision based on the consistency between the medication information and the medical condition information.* (see at least Lerner [0024])

As per claim 15, Lerner teaches the steps of:

- *means for querying a medical knowledge database, the database comprises information associated with a plurality of medications, a plurality of medical conditions, and treatment associations between the plurality of medications and the plurality of medical conditions.* (see at least Lerner [0017])

As per claim 16, Lerner teaches:

- *means for assigning the applicant to a risk category based on the consistency between the medication information and the medical condition information.* (see at least Lerner Fig. 2 Items:56,72 and related text)

7. Claims 2, 6, 10, 14 & 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lerner in view of Joao (US 2001/0032099 A1) (hereinafter Joao) in further view of Ghouri.

Claim 2

Lerner as shown, discloses all the limitations of Claim 1 and the following limitations:

- *comparing the list with the medical condition information provided by the applicant.* (see at least Lerner [0012] “The computer system retrieves and utilizes this information to produce an underwriting score or value, where information gathered from the potential customer is compared to information within an insurer database.” Wherein the “information gathered from the potential customer” reads *on medical condition information.*)

Lerner does not disclose the following limitations, however Joao, as shown does:

- *generating a list of possibly treated conditions based at least in part on the medication information provided by the applicant;* (see at least Joao [0215] “then generate a treatment report which will outline and/or prescribe treatment for the single diagnosis and/or for the list of possible diagnoses, if any. The central processing computer 10, when generating the treatment report, can process same in conjunction with, and consider, possible drug interactions and/or treatment interactions.”)

It would have been obvious to one of ordinary skill in the art to add the features of Joao into Lerner, One of ordinary skill in the art would have added these features into Lerner with the motivation to provide an improved invention for effectively and efficiently analyzing and managing decisions regarding healthcare insurance, diagnosis, treatment, cost efficiency in order to provide enhanced medical care. (see at least Joao [0012]-[0019]).

Claim 6

Lerner as shown, discloses all the limitations of Claim 5 and the following limitations:

- *code adapted to compare the list with the medical condition information provided by the applicant. (see at least Lerner [0012])*

Lerner does not disclose the following limitations, however Joao, as shown does:

- *code adapted to generate a list of possibly treated conditions based at least in part on the medication information provided by the applicant; (see at least Joao [0215])*

It would have been obvious to one of ordinary skill in the art to add the features of Joao into Lerner, One of ordinary skill in the art would have added these features into Lerner with the motivation to provide an improved invention for effectively and efficiently analyzing and managing decisions regarding healthcare insurance, diagnosis, treatment, cost efficiency in order to provide enhanced medical care. (see at least Joao [0012]-[0019]).

Claim 10

Lerner as shown, discloses all the limitations of Claim 9 and the following limitations:

- *a comparison module for comparing the list with the medical condition information provided by the applicant. (see at least Lerner [0012])*

Lerner does not disclose the following limitations, however Joao, as shown does:

- *a generation module for generating a list of possibly treated conditions based at least in part on the medication information provided by the applicant; (see at least Joao [0215])*

It would have been obvious to one of ordinary skill in the art to add the features of Joao into Lerner, One of ordinary skill in the art would have added these features into Lerner with the motivation to provide an improved invention for effectively and efficiently analyzing and managing decisions regarding healthcare insurance, diagnosis, treatment, cost efficiency in order to provide enhanced medical care. (see at least Joao [0012]-[0019]).

Claim 14

Lerner as shown, discloses all the limitations of Claim 13 and the following limitations:

- *means for comparing the list with the medical condition information provided by the applicant. (see at least Lerner [0012])*

Lerner does not disclose the following limitations, however Joao, as shown does:

- *means for generating a list of possibly treated conditions based at least in part on the medication information provided by the applicant; (see at least Joao [0215])*

It would have been obvious to one of ordinary skill in the art to add the features of Joao into Lerner, One of ordinary skill in the art would have added these features into Lerner with the motivation to provide an improved invention for effectively and efficiently analyzing and managing decisions regarding healthcare insurance,

diagnosis, treatment, cost efficiency in order to provide enhanced medical care.

(see at least Joao [0012]-[0019]).

Claim 17

Lerner as shown, discloses the following limitations:

- *identifying medical condition information provided by the applicant; (see at least Lerner [0022])*
- *assessing a consistency between the medication information and the medical condition information; (see at least Lerner [0023])*
- *such assessing including performing a comparison between the medication information and the method condition information; (see at least Lerner [0012])*
- *making at least one insurance underwriting decision based on the consistency between the medication information and the medical condition information, the making at least one insurance underwriting decision performed by the processor; (see at least Lerner [0024])*
- *querying a medical knowledge database, the database comprises information associated with a plurality of medications, a plurality of medical conditions, and treatment associations between the plurality of medications and the plurality of medical conditions, and generating the list of possibly treated conditions based on results from the querying of the medical knowledge database; (see at least Lerner [0017])*

Lerner does not disclose the following limitations, however Joao, as shown does:

- *generating a list of possibly treated conditions based at least in part on the medication information provided by the applicant; (see at least Joao [0215])*

It would have been obvious to one of ordinary skill in the art to add the features of Joao into Lerner. One of ordinary skill in the art would have added these features into Lerner with the motivation to provide an improved invention for effectively and efficiently analyzing and managing decisions regarding healthcare insurance, diagnosis, treatment, cost efficiency in order to provide enhanced medical care. (see at least Joao [0012]-[0019]).

Lerner/Joao does not disclose the following limitations, however Ghouri, as shown does:

- *identifying medication information provided by an applicant; (see at least Ghouri [0019] Fig:1,2 & related text)*
- *assessing a consistency between the medication information and the medical condition information; (see at least Ghouri [0019] Fig:1,2 & related text)*
- *comparing the list of possibly treated conditions with the medical condition information provided by the applicant, the comparing resulting in the consistency being identified between the medication information and the medical condition information. (see at least Ghouri [0019] Fig:1,2 & related text)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the features of Ghouri into Lerner. One of ordinary skill in the art would have added these features into Lerner with the motivation to provide a

more efficient and accurate approach to assessing the consistency between medication information and the medical conditions in order to yield more informed and beneficial medical decisions. (see at least Ghouri [0008]-[0013])

Claim 18

The combination of Lerner/Joao discloses all of the limitations of claim 17. Lerner further discloses the following limitation:

- *assigning the applicant to a risk category based on the consistency between the medication information and the medical condition information. (see at least Lerner Fig. 2 Items:56,72 and related text)*

Response to Arguments

10. Applicant's arguments filed 22 June 2009 have been fully considered but they are not persuasive.

11. Applicant's assumption that "Applicant's 05 February, 2009 Argument were persuasive" has been considered, however Examiner finds this assumption to be incorrect and unfounded. Examiner's "new grounds of rejection" in the previous Office Action was in response to Applicant's substantial amendments in previous claim set.

12. Applicant argues that Examiner's rejection of "*making at least one insurance underwriting decision based on the consistency between the medication information and the medical condition information pages*" is deficient in a fundamental manner. Examiner finds this argument to be completely unpersuasive because Lerner is

about "making at least one insurance underwriting decision", and Applicant's argument regarding "consistency" is dealt with in the other cited prior art.

13. Applicant argue that the "present rejection simply fails to articulate sufficient findings of fact to support the rejection", as a basis for the rejection to be withdrawn.

Examiner finds Applicant's argument to be unpersuasive and further Applicant shows no factual support for this assertion.

14. Applicant's argues that prior art source, Lerner, does not disclose "assessing consistency . . .", however Examiner points out that this argument is irrelevant because this aspect of the claims is disclosed by cited prior art source, Ghouri. (see at least Ghouri [0018-20], [0072])

15. In response to applicant's arguments for the allowability of claims 3 & 4 based on their dependency on claim 1, these claims are rejected on the same grounds as addressed in Claim 1.

16. Applicant's arguments for the allowability of claims 5, 9 & 13 are substantially the same as the argument as claim 1, and thus claims 5, 9 & 13 are rejected on substantially similar grounds as claim 1.

17. In response to applicant's arguments for the allowability of claims 7,8,11,12 & 15-16 based on their dependency on claims 5,9 & 13, these claims are rejected on the same grounds as addressed in Claims 5,9 & 13.

18. Examiner respectfully disagrees with Applicant's argument that claims 7,8,11,12 & 15-16 'recite additional features which are not disclosed, or even suggested, by the cited references", and points out that applicant's assertion is unsupported.

19. Applicant's arguments for the allowability of claim 17 is substantially the same as the argument as claim 1, and thus claim 17 is rejected on substantially similar grounds as claim 1.

20. In response to applicant's arguments for the allowability of claims 2,6,10,14 & 18 based on their dependency on claims 1,5,9, 13 & 17 these claims are rejected on the same grounds as addressed in Claims 1,5,9, 13 & 17.

21. Further, Examiner respectfully disagrees with Applicant's argument that the claim limitations of 2,6,10,14 & 17-18 cited by Joao is unsupported.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAJIV J. RAJ whose telephone number is (571) 270-3930. The examiner can normally be reached on Monday thru Friday 8-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

Date: 08/29/09

/RJR/

Patent Examiner, Art Unit 3686

/Gerald J. O'Connor/
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